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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/814,928	02/27/1997	VISHRAM P. DALVI	42390.P4024	5243

7590 07/21/2004

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EXAMINER

ROBERTSON, DAVID L

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 07/21/2004

44

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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Commissioner for Patents

See attached.

David L. Robertson
Primary Examiner
Art Unit: 2186

This is in response to the RCE filed March 23, 2004 and the Amendment filed April 23, 2004.

Newly amended claims 31-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 31-37 as filed in the amendment of April 24, 2000 were drawn to an invention initially elected on December 3, 1998. The examiner's outstanding rejections of these claims have recently been affirmed by the Board of Patent Appeals and Interferences on January 23, 2004. Applicants have recently amended these claims to incorporate limitations from the previously presented, but non-elected invention. Thus, while the previously presented two inventions were related as subcombinations usable together, the claims as currently amended are related to the claims previously rejected invention as combination and subcombination, and the amendment therefore constitutes a shift to another invention. Note that the combination (i.e., the claims as currently amended) clearly does not rely on the particulars of the subcombination (i.e., the claims as affirmed by the Board of Appeals) for patentability, and because the subcombination clearly has utility by itself (as noted by the previous prosecution) or in other combinations (intuitively evident), the invention of claims 31-37 as previously examined (i.e., directed to the subcombination) is distinct from the invention of the recently amended claims 31-37 (i.e., the combination); therefore these different versions of the claims are directed to different inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Note that applicants cannot, as a matter of right, file a request for continued examination on the claims as presently amended (see M.P.E.P. § 819). Instead, applicants must file a divisional application under , a continuation in part application under or some other appropriate means.

As noted above, applicants are not entitled to shift from claiming one invention to claiming another. In this case, in view of the Board of Appeal's decision, applicants are clearly relying on the features of the previously non-elected invention for patentability. However, because certain of the features of the non-elected invention have never been searched or considered, allowing such a shift would result in additional work and does not reduce work by simplifying the issues (see M.P.E.P. § 819.01).

The amendment filed on April 23, 2004 amending the claims drawn to the elected invention resulting only in claims relying on a previously non-elected invention for patentability is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because the all now include details directed to at least one bit indicating that a write operation was suspended due to an attempt to access data in a protected memory circuit.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

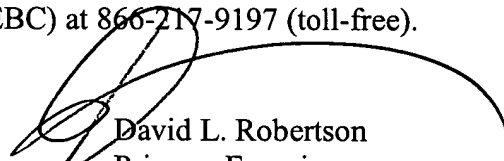
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Robertson whose telephone number is (703) 305-3825.

The examiner can normally be reached on weekdays from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim, can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David L. Robertson
Primary Examiner
Art Unit 2186